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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/619,198	07/19/2000	Hai Yan	MBHB00-422	2259

7590 10/21/2002

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EXAMINER

HAYES, ROBERT CLINTON

ART UNIT	PAPER NUMBER
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1647

DATE MAILED: 10/21/2002 //

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/619,198

Applicant(s)
Yan et al

Examiner
Robert C. Hayes, Ph.D.

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1647



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 26, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 6-9, and 11-13 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 8, and 9 is/are allowed.
- 6) ☒ Claim(s) 6 and 11 is/are rejected.
- 7) ☒ Claim(s) 7, 12, and 13 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Response to Amendment

1. The amendment filed 7/26/02 has been entered. Note that claim 6 of the “clean version” is incorrect, as amended.
2. The rejection of claims 1, 3 & 5-13 under 35 U.S.C. 112, first paragraph, for lack of written description is withdrawn due to the cancellation or amendment of the claims, and Applicants’ arguments.
3. The rejection of claims 1, 3 & 5-13 under 35 U.S.C. 112, first paragraph, for lack of enablement is withdrawn due to the cancellation or amendment of the claims.
4. The rejection of claims 3 & 5-13 under 35 U.S.C. 112, second paragraph, as being indefinite is withdrawn due to the cancellation or amendment of the claims.
5. The rejection of claims 1, 3, 5 & 8-10 under 35 U.S.C. 102(b) as being anticipated by Salton et al. (1991) is withdrawn due to the cancellation or amendment of the claims.
6. The rejection of claims 3, 5-6 & 8-11 under 35 U.S.C. 102(b) as being anticipated by Possenti et al. (1989) is withdrawn due to the cancellation or amendment of the claims.

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7. The rejection of claims 5-6 & 10-11 under 35 U.S.C. 102(b) as being anticipated by Canu et al. is withdrawn due to the cancellation or amendment of the claims.

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Applicant's arguments filed 7/26/02 have been fully considered but they are not deemed to be persuasive.

10. The drawings stand objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description, for the reasons made of record in Paper NO: 8. Correction is required.

It remains unknown what the number values represent in Figures 2-3. It is also unknown what #2, #6, #7 & #1 represent in Figure 1.

11. Claims 6 & 11 stand rejected under 35 U.S.C. 102(b) as being anticipated by Salton et al. (1991), for the reasons made of record in Paper No: 9 and as follows.

Applicants argue on page 5 of the response that Salton's protein sequence "is not fused to a heterologous sequence". In contrast to Applicants' assertions, all additional sequences

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connected/fused to SEQ ID NO:7 are heterologous sequences, by definition. Therefore, Applicants' arguments are not persuasive.

In summary, Salton et al. teach the sequence of rat VGF/NGF33.1 which comprises "the amino acid sequence as set forth in... SEQ ID NO:7 (i.e., pg. 993, Fig. 1), which by definition meets the limitations of being a "fusion polypeptide comprising the polypeptide of... SEQ ID NO:7", because additional heterologous amino acid residues sequences are fused to the polypeptide of SEQ ID NO:7 (i.e., as it relates to claim 6). In that a "polymer" of water soluble amino acid residues are covalently attached to SEQ ID NO:7 in Salton's polypeptide, the limitations of claim 11 are further still met.

12. Claims 1 & 8-9 are allowed.

13. Claims 7 & 12-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Robert Hayes whose telephone number is (703) 305-3132. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached on (703) 308-4623. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Robert C. Hayes, Ph.D.
October 17, 2002


GARY KUNZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1800